

REMARKS

In the *Office Action*, prosecution of the pending application (*Instant Application*) was reopened in view of the Appeal Brief filed on June 1, 2011. The Examiner rejected claims 1-24 and 26-30. No claims are added or canceled by this response. Claims 19-23 are amended. No new matter is introduced. Based on the foregoing amendments and the following remarks, the Applicant respectfully requests reconsideration of the *Instant Application*.

Rejections under 35 U.S.C. § 101

Claims 19-23 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter wherein the claim recites a processing program that is not claimed as embodied in a non-transitory storage medium. *Office Action*, page 2 ¶ 7. While the Applicant does not necessarily agree with the Examiner, claims 19-23 were amended to in part recite “[a] non-transitory computer readable storage medium” in the interest of advancing prosecution of the *Instant Application*.

Rejections under 35 U.S.C. § 103 over *Yoshida*, *Mott*, and *GT 3*

Claims 1-24 and 26-30 were rejected as being obvious over U.S. patent no. 6,652,376 (*Yoshida*) in view of U.S. patent no. 5,269,687 (*Mott*), in yet further view of Gran Turismo 3 (*GT3*, released April 28, 2001). *Office Action*, page 2 ¶ 3 through page 3 ¶ 1. Because the combination of *Yoshida*, *Mott*, and *GT 3* fails to make obvious each limitation of claims 1-24 and 26-30, the Applicant asserts that these claims are patentable over the cited art.

The cited art does not teach or suggest “displaying the graphical path data as a visual string of path markers.”

Claim 1 in part recites “displaying the graphical path data as a visual string of path markers.” In other words, the graphical path data is retrieved and displayed, and the retrieved graphical path data **does not change** based upon actions of the user. *Instant Application*, ¶ [0015]. In this way, players may test themselves against, for example, a “‘best time’ path generated by a developer of game software and permanently stored on a game disc.” *Instant Application*, ¶ [0015].

The Examiner contends that *Yoshida* teaches this feature:

Yoshida discloses retrieving graphical path data associated with a previous run in that the other video game system displays a reference path travel line established by a previous run (col. 11, lines 37-41), wherein the reference path may be displayed as a visual string of path markers (Fig. 9, 10, 14, 15, 19).

Office Action, page 5 ¶ 1.

The Applicant respectfully disagrees with the Examiner’s interpretation of *Yoshida*. *Yoshida* teaches a driving game having an assist mode in which auto-brake control is performed and a training mode. *Yoshida*, Abstract. As understood from the sections of *Yoshida* cited by the Examiner, the Examiner equates the claimed graphical path data with the brake indication region of the reference travel line LN_{ref} of *Yoshida*. *Office Action*, 5 ¶ 1. Unlike the claimed graphical path data, the brake indication region of the reference travel line LN_{ref} of *Yoshida* **changes** through the game based upon the player’s control of the game:

the CPU 21 then **changes the shape of the reference travel line** in blocks wherein brake data DB is not zero pursuant to brake data DB which has been altered (step 548). Then, the reference travel line LN_{ref} including such changed line portion is displayed (step 549).

Yoshida, col. 11, lines 12-17. (emphasis added.)

reference travel line LN_{ref} of reference data $DATA_{ref}$ of blocks belonging to this course range **is subject to changes** in the shape thereof.

Yoshida, col. 11, lines 12-17. (emphasis added.)

Hence, *Yoshida* does not teach the claimed “displaying the graphical path data as a visual string of path markers.”

The cited art does not teach or suggest “determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path.”

Claim 1 in part recites “determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path.” The Examiner determined that *Yoshida* does not teach this claimed feature:

Yoshida does not specifically disclose determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run.

Office Action, page 5 ¶ 2.

Instead, the Examiner relies upon Mott to teach this feature:

(Fig. 5, Current Lap 192, Previous Best Lap 194, Lap Time 162; col. 5, lines 60-67). That is, Mott displays an elapsed time from a starting point to a current location as the player approaches the finish line in the form of a Current Lap time display (Fig. 5), which measures the amount of time that has elapsed from the beginning of the race until the player reaches the finish line point. Mott visually displays a comparison of a current elapsed time to a previously recorded time from a starting point to a finish line location of a player in the Previous Best Lap time display (Fig. 5).

Office Action, page 5 ¶ 2 through page 6 ¶ 1.

In addition, the Examiner contended that a hypothetical combination of *Yoshida* and *Mott* would somehow transform a simulated dashboard of *Mott* and the brake indication region of the reference travel line LN_{ref} of *Yoshida* into the claimed displayed path marker:

It would have been obvious to one of ordinary skill in the art to combine the color changing graphical path markers of *Yoshida* with the current and previous lap time indicators of *Mott* as these are both a means of visually providing information to a player during a video game play session.

Office Action, page 6 ¶ 2.

The Applicant respectfully disagrees.

Mott teaches a driver training system for a user of a simulated vehicle. *Mott*, Abstract. The sections of *Mott* cited by the Examiner merely disclose a dashboard of a simulated vehicle. *Mott*, Figures 3-5. At best, the supposed combination of *Yoshida* and *Mott* would place the simulated dashboard of *Mott* in the display of *Yoshida*. Nor is there teaching or suggestion in either reference to take all or some of the gauges from the dashboard of *Mott* and somehow incorporate them in the braking indication region BK of the reference travel line LN_{ref} of *Yoshida*. Hence, the supposed combination of *Yoshida* and *Mott* do not teach the claimed “determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path.”

It would not have been obvious to one of ordinary skill in the art at the time of invention to combine *Yoshida* and *Mott*.

The Examiner contended that it would have been obvious to combine *Yoshida* and *Mott*:

It would have been obvious to one of ordinary skill in the art to combine the color changing graphical path markers of *Yoshida* with the current and previous lap time indicators of *Mott* as these are both a means of visually providing information to a player during a video game play session. Further, *Mott* specifically discloses providing indicators for speed similar to the invention disclosed by *Yoshida*. To provide a visual indication of current lap time compared to a previous lap time is known in a racing-type video game system; providing an indication of a game parameter in the form of color changing path markers is also known in a racing-type video game system. To modify *Yoshida*'s color changing markers to provide an indication of a currently elapsed time compared to a previously recorded elapsed time, instead of based upon current speed compared to a previously recorded ideal speed, would have required only routine skill in the art. Thus, all of the combined elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Office Action, page 6 ¶ 2.

The Applicant respectfully disagrees.

As noted above, a hypothetical combination of *Yoshida* and *Mott* would merely place the simulated dashboard of *Mott* in the display of *Yoshida*. Also as noted above, *Yoshida* and *Mott* are devoid of teaching or suggestion to incorporate all or some of the gauges from the dashboard of *Mott* in the braking indication region BK of the reference travel line LN_{ref} of *Yoshida* to somehow arrive at the claimed invention. Nevertheless, the Examiner contended that “only routine skill in the art” would be needed to take information displayed in analog gauges in the dashboard of *Mott*, perform calculations on the information, and change the braking indication region BK of the reference travel line LN_{ref} of *Yoshida* to reflect elapsed time instead of when to apply the brakes.

However, pursuant to the Supreme Court's decision in *KSR v. Teleflex*, the Examiner must still provide some motivation for the combination regardless of whether the elements were previously known to exist in the art. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). The mere fact that references **can** be combined or modified does not render the resultant combination obvious. *Id.* (emphasizing importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does"). Following *KSR v. Teleflex*, the Federal Circuit further articulated that the requisite motivation underlying a conclusion of obviousness is a "motivation to combine **particular references to reach the particular claimed method.**" *Innogenetics, NV v. Abbott Laboratories*, 512 F.3d 1363, 1373-74 n. 3 (Fed. Cir. 2008) (emphasis added).

The Applicant further submits that the **supposed** combination of *Yoshida* and *Mott* is improper because the *Office Action* relies on information gleaned solely from the Applicant's specification. MPEP § 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the **facts gleaned from the prior art.**" (emphasis added). "Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure**, such a reconstruction is proper." MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971), (emphasis added).

Moreover, the dramatic modification suggested by the Examiner would render *Yoshida* unsuitable for its intended purpose. Given the level of difficulty the driving game of *Yoshida* must offer experienced players, the braking indication region is central to *Yoshida*, because it allows beginners to enjoy the game: “beginners and players who are poor at driving are not able to achieve good scores, and there is a problem in that their interest in the game would languish.” *Yoshida*, Abstract. Accordingly, Figures 7-23 all depict a braking indication region BK. *Yoshida*, Figures 7-23, col. 11, line 60 through col. 12, line 37. The braking indication region, as its name implies, indicates to the player the “timing of the brake point” (i.e., when to apply the simulated vehicles brakes). *Yoshida*, Abstract. Figure 18, for example, instructs the player to “brake!” in Japanese. *Yoshida* also teaches a computer generated voice to tell the player “this is a braking point.” *Yoshida*, col. 12, lines 53-55.

If *Yoshida* were somehow modified as the Examiner suggests so that “*Yoshida*’s color changing markers [were modified] to provide an indication of a currently elapsed time compared to a previously recorded elapsed time,” instead of when to brake, then beginners would lose the game quickly and stop playing the game. Recall that *Yoshida* is supposed to solve the problem of “beginners and players who are poor at driving are not able to achieve good scores, and there is a problem in that their interest in the game would languish.” *Yoshida*, Abstract. Removing the braking indication region BK eliminates an essential part of *Yoshida*. Furthermore, displaying an indication of elapsed time would also only encourage beginning players to drive faster and not apply the brakes, which would result in the player losing the game and losing interest in the game. Hence, the combination and modification of *Yoshida* and *Mott* suggested by the Examiner would only render *Yoshida* unsuitable for its intended purpose.

Because the cited art does not disclose each and every element of claim 1 and one of ordinary skill in the art could not have combined the cited references to produce the invention of claim 1, claim 1 is not obvious in view of the cited art and should be allowed. Independent claims 19, 24, and 30 contain similar elements as independent claim 1, and are therefore allowable for similar reasons as claim 1.

To support a conclusion that a claim would have been obvious requires that all the claimed elements were known in the prior art and that one skilled in the art could have combined those elements. See *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007); see also MPEP § 2143. Based at least on the remarks herein, the Applicant submits that independent claims 1, 19, 24, and 30 are patentable over the cited references. Furthermore, as a dependent claim incorporates by reference all the limitations of the claim from which it depends (see 35 U.S.C. § 112 ¶ 4), the rejections of claim 2-18, 20-23, and 26-29 under 35 U.S.C. § 103(a) are overcome for at least the same reasons as the amended independent claims 1, 19, 24, and 30. The Applicant has for brevity chosen not to individually discuss the additional distinguishing characteristics of the dependent claims. The Applicant's silence should not be interpreted as belief that the dependent claims are patentable only by virtue of their dependence on a patentable independent claim.

CONCLUSIONS

Based on the foregoing amendments and remarks, the Applicant believes the rejections have been overcome, and that the *Instant Application* is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact the Applicant's undersigned representative.

Respectfully submitted,
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November 7, 2011

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